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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/556,012	02/01/2007	Herbert Meyerle	S118.12-0006	3092
27367 7590 12/27/2010 WESTMAN CHAMPLIN & KELLY, P.A. SUITE 1400 900 SECOND AVENUE SOUTH MINNEAPOLIS, MN 55402				
EXAMINER				
BARRETT, SUZANNE LALE DINO				
ART UNIT		PAPER NUMBER		
3673				
MAIL DATE		DELIVERY MODE		
12/27/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/556,012

Applicant(s)

MEYERLE, HERBERT

Examiner

Suzanne Dino Barrett

Art Unit

3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,8-19,33,34,37-42,44-61 and 64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,8-19,33,34,37-42,44-61 and 64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/16/10 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 3,13,16,45,62,65,66 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is insufficient disclosure for the elected Figure 4 embodiment as to the mechanical potential, guide means, slide surfaces and slide elements, mass center of the coupling locking element (claim 45) are not understood with respect to the Figure 4 embodiment, as there is insufficient disclosure on pages 19-20 for these elements.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-5,8-19,33,34,37-42,44-61,64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. In addition, there are several terms lacking clear antecedent basis.

For example, in claim 1, line 9-11, the phrase "causes a movement component...being orthogonal" is grammatically awkward; in lines 12-13, it is not understood how a coupling locking element can be "located between the at least one coupling element.", i.e. **between** a single coupling element. In claim 2, line 6, insert –a— before "decoupled state" and line 7, "at least one coupling elements" should be –at least one coupling element—(singular); line 9, "components" should be –component--; line 10, "being orthogonal" is grammatically awkward; line 12-13, in the phrase "located between coupling elements", "coupling elements" lacks clear antecedent basis since this should read –at least one coupling element--, and consequently, it is not understood how something can be "between" one element. In claim 4, line 3 and throughout the claims, "by" replacing "via" in the amendments to the claims, does not overcome the indefiniteness rejection - since the claims are narrative, the recitation of causing a

decoupling or coupling “by the at least one coupling element” does not necessarily connote that the coupling element causes the coupling/decoupling but could also mean that it is nearby the coupling element thereby being indefinite. In claim 9, line 2, there is no antecedent basis for “the at least one coupling elements” and line 4, the recitation of “stronger and more reliable” is indefinite since it is not clear with respect to what strength and reliability it is compared to, and also in line 5, “an” should be —a—. In claim 11, line 2, as discussed with respect to claim 4, “by” is indefinite. In claim 12, there is no antecedent basis for “the actuator” since no actuator is recited in claim 1 or claim 9. In claim 17, line 2, “in such a manner” is considered an indefinite recitation; line 4, “being orthogonal thereto is considered indefinite, and line 6, it is unclear what direction “a same direction” refers to (same as what?). In claim 18, line 2, insert —a—before “movement”. In claim 38, line 2, “in such a manner” is considered an indefinite recitation and insert —a—before “radial. In claim 40, line 2, there is no antecedent basis for “the inner side”. In claim 42, line 4, “thereby” lacks antecedent basis. In claim 44, line 2, “in such a manner” is considered an indefinite recitation. In claim 45, line 4, “its rotational axis that...” is grammatically awkward. In claim 47, line 2, there is no antecedent basis for “the actuator”. In claim 48, line 3, there is no antecedent basis for “the electromagnet arrangement of the actuator”. The following lack antecedent basis; in claim 50, line 2, “the actuator” and line 4, “the spring forces”; claim 52, line 3, “the actuator”; claim 53, line 3, “the electromagnet arrangement of the actuator” and line 5, “the coupling elements”; claim 55, “the actuator”; claim 56, line 3, “it” and “the actuator”; claim 59, line 3, “the electromagnet arrangement of the actuator”, and also, “especially” in line 4, is

considered indefinite; in claim 60, line 1 "the actuator, line 3, "the effective direction of the magnetic field" and line 4, "the attack direction".

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-5,8-19,33,34,37-42,44-61,64, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Rathmann et al 6,112,564. As best understood, Rathmann et al teach a device comprising a drive, a take-off (1.1), an orthogonal coupling element (1.11) having a spring bias (1.12), an actuator (2.1) comprising a motor, electromagnet and/or remote transponder, switch means, stop means, and coupling lock element (2.6) with lock spring (2.3). It is noted that the mechanical potential limitations are not understood and deemed to be taught by Rathmann et al disclosing the claimed structure.

Response to Arguments

8. Applicant's arguments filed 11/16/10 have been fully considered but they are not persuasive. As set forth above, Applicant has failed to fully respond to the previous rejection under 35 USC 112, first paragraph. The current remarks accompanying the response of 11/16/10 do not provide clear disclosure or explanation for the listed

elements. Accordingly, these elements are still not understood. Furthermore, Applicant has failed to fully respond to the rejection set forth under 35 USC 112, second paragraph. As set forth above, the rejection now specifically sets forth all of the claims containing issues. Until the scope of the invention can be clearly ascertained, the Rathmann '564 reference is applied against the claims as best understood and applicant's arguments regarding Rathmann '564 are not persuasive.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suzanne Dino Barrett whose telephone number is 571-272-7053. The examiner can normally be reached on M-Th 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Cuomo can be reached on 571-272-6856. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Suzanne Dino Barrett
Primary Examiner
Art Unit 3673

sdb
/Suzanne Dino Barrett/
Primary Examiner, Art Unit 3673